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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,753	03/16/2004	Hideaki Takahashi	118333	1184
25944 7590 03/27/2008 OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850				
EXAMINER				
GAUTHIER, GERALD				
ART UNIT		PAPER NUMBER		
2614				
MAIL DATE		DELIVERY MODE		
03/27/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/800,753

**Applicant(s)**

TAKAHASHI, HIDEAKI

**Examiner**

Gerald Gauthier

**Art Unit**

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 42-50 is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-18, 20, 21, 23-39, 41, 51 and 52 is/are rejected.
- 7) ☒ Claim(s) 7, 19, 22 and 40 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 51 and 52** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. A computer program product is a software and cannot be claimed as a statutory matter. The software has to be embedded into a tangible medium to be statutory.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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4. **Claims 1-6, 8-18, 20, 21, 23-39, 41, 51 and 52** are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakata et al (US 5,442,685) in view of Peavey et al. (US 5,533,103).

Regarding **claims 1 and 51**, Sakata discloses a telephone terminal having a function of telephone communication (FIG. 1 and column 1, lines 14-15), comprising:

a communication recording unit that records the telephone communication as communication data [The answering machine records the conversations between the operator and a conversational partner, column 10, lines 23-27];

an interruption controller that controls the communication recording unit to interrupt and to restart recording the telephone communication, the communication recording unit indexing a position, in the communication data, corresponding to the interruption of recording [The control circuit 19 stops the recording and restart the recording when the switch records is turned on, column 9, line 60 to column 10, line 3];  
and

a replaying unit that replays the telephone communication as recorded based on the communication data, the replaying unit notifying that the recording was interrupted at the indexed position [The telephone answering apparatus reproduces the message recorded, column 5, lines 1-15].

Sakata fails to disclose recording the telephone communication if the interruption occurs within a single call.

However, Peavey teaches recording the telephone communication if the interruption occurs within a single call [The call manager executed a suspend request of

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recording of the call conversation and resume the recording in a single call, column 9, lines 34-46].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Sakata using the teaching of interrupting of recording as taught by Peavey.

This modification of the invention enables the system to have the interruption occurs within a single call so that the user would verify the transaction on the basis of recording information.

Regarding **claims 2 and 35**, Sakata discloses a telephone terminal, wherein the interruption controller controls the communication recording unit to stop recording when a first condition is satisfied, and wherein the interruption controller controls the communication recording unit to restart recording when a second condition is satisfied (column 10, lines 4-22).

Regarding **claims 3 and 36**, Sakata discloses a telephone terminal, wherein the first condition is that a user operates the telephone terminal to switch a person subjected to the telephone communication from a first person to a second person according to a call-waiting function when the telephone communication with the first person is being recorded (column 10, lines 28-50).

Regarding **claims 4 and 37**, Sakata discloses a telephone terminal, wherein the second condition is that the user operates the telephone terminal to switch a person subjected to the telephone communication from the second person to the first person when the telephone communication with the first person is being interrupted (column 10, lines 4-22).

Regarding **claims 5 and 38**, Sakata discloses a telephone terminal, an execution of a predetermined operation when the telephone communication is being recorded satisfies the first condition (column 10, lines 28-50).

Regarding **claims 6 and 39**, Sakata discloses a telephone terminal, wherein the predetermined operation includes an operation of a predetermined operable member provided to the telephone terminal (column 10, lines 28-50).

Regarding **claims 8 and 41**, Sakata discloses a telephone terminal, wherein the predetermined operation is an operation to hold the telephone communication (column 9, lines 33-53).

Regarding **claim 9**, Sakata discloses a telephone terminal, wherein the operation to release the holding condition of the telephone communication satisfies the second condition (column 10, lines 28-50).

Regarding **claim 10**, Sakata discloses a telephone terminal, an execution of a predetermined operation when the telephone communication is being interrupted satisfies the second condition (column 10, lines 28-50).

Regarding **claim 11**, Sakata discloses a telephone terminal, wherein the predetermined operation includes an operation of a predetermined operable member provided to the telephone terminal (column 10, lines 4-22).

Regarding **claim 12**, Sakata discloses a telephone terminal, wherein the interruption controller is capable of controlling the communication recording unit to interrupt and restart the recording of the telephone communication plurality of times during one telephone call, the communication recording unit indexing a plurality of positions, in the communication data, respectively corresponding to the plurality of interruptions of recording (column 10, lines 28-50).

Regarding **claim 13**, Sakata discloses a telephone terminal, wherein the telephone communication recording unit indexes the interrupted position by inserting predetermined data at the position of the communication data corresponding to the interruption (column 10, lines 28-50).

Regarding **claim 14**, Sakata discloses a telephone terminal, wherein the interruption controller is capable of measuring a duration of the interruption of the

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recording of the telephone communication, the duration of the interruption being added to the predetermined data (column 10, lines 28-50).

Regarding **claim 15**, Sakata discloses a telephone terminal, wherein the replaying unit notifies the duration of the interruption in accordance with the predetermined data (column 9, lines 1-15).

Regarding **claim 16**, Sakata discloses a telephone terminal, wherein the replaying unit notifies the duration as a voice message (column 9, lines 1-15).

Regarding **claim 17**, Sakata discloses a telephone terminal, wherein the replaying unit executes different operations based on the duration of the interruption (column 10, lines 28-50).

Regarding **claim 18**, Sakata discloses a telephone terminal, wherein the replaying unit notifies the duration only when the duration is longer than a predetermined period (column 10, lines 28-50).

Regarding **claim 20**, Sakata discloses a telephone terminal, wherein a quantity of the predetermined data is less than a quantity of data which would be generated if the communication data is kept recorded during a duration of the interruption (column 10, lines 28-50).



Regarding **claim 21**, Sakata discloses a telephone terminal, wherein the predetermined data includes voice data representing a predetermined message (column 9, lines 25-31).

Regarding **claim 23**, Sakata discloses a telephone terminal, wherein the predetermined data includes silent data (column 9, lines 54-65).

Regarding **claim 24**, Sakata discloses a telephone terminal, wherein the predetermined data includes audio data representing a predetermined audio sound (column 9, lines 54-65).

Regarding **claim 25**, Sakata discloses a telephone terminal, wherein the replaying unit outputs a predetermined sound at the indexed position of the communication data (column 10, lines 28-50).

Regarding **claim 26**, Sakata discloses a telephone terminal, wherein the replaying unit outputs a predetermined message at the indexed position of the communication data (column 10, lines 28-50).

Regarding **claim 27**, Sakata discloses a telephone terminal, further comprising a data processor that applies a fade-out effect to part of the communication data immediately before the indexed position (column 10, lines 28-50).

Regarding **claim 28**, Sakata discloses a telephone terminal, further comprising a data processor that applies a fade-in effect to part of the communication data immediately after the indexed position (column 10, lines 28-50).

Regarding **claim 29**, Sakata discloses a telephone terminal, wherein the telephone communication recording unit starts recording the telephone communication in response to a predetermined operation by a user (column 9, lines 33-53).

Regarding **claim 30**, Sakata discloses a telephone terminal, wherein the predetermined operation is an operation of a predetermined operable member provided to the telephone terminal (column 9, lines 33-53).

Regarding **claim 31**, Sakata discloses a telephone terminal, wherein the predetermined operation is an off-hook operation (column 10, lines 28-50).

Regarding **claim 32**, Sakata discloses a telephone terminal, wherein the telephone communication recording unit finishes recording the telephone communication in response to a predetermined operation by a user (column 10, lines 28-50).

Regarding **claim 33**, Sakata discloses a telephone terminal, wherein the predetermined operation is an on-hook operation (column 10, lines 28-50).

Regarding **claims 34 and 52**, Sakata in combination with Peavey disclose all the limitations of claims 34 and 52 as stated in claim 1's rejection above. Furthermore Sakata discloses a data controller that controls the communication recording unit to apply a predetermined operation to the communication data in accordance with the indexed position [The memory circuit supplies various control signal to the apparatus, which are the indexed position, column 9, lines 1-15].

### ***Allowable Subject Matter***

5. **Claims 42-50** are allowed.
6. **Claims 7, 19, 22 and 40** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Dewan is cited for pausing a session with an IVR.
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (571) 272-7539. The examiner can normally be reached on 8:00 AM to 4:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gerald Gauthier/  
Primary Examiner, Art Unit 2614

/GG/  
March 28, 2008